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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,075	02/11/2004	Kensaku Shinozaki	042100	3422
38834 7590 10/09/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
VAN, LUAN V				
ART UNIT		PAPER NUMBER		
1795				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/775,075

**Applicant(s)**

SHINOZAKI, KENSAKU

**Examiner**

LUAN V. VAN

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 7-10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 11, 2008 has been entered.

### ***Response to Amendment***

Applicant's amendment of September 11, 2008 does not render the application allowable. Claims 1-3, 10, 12 and 13 are presently pending.

### ***Status of Objections and Rejections***

All rejections of under 35 USC 102(b) as being anticipated by Wolski et al. '140 are withdrawn. All other rejections from the previous office action are maintained.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention.

Regarding claim 2, the instant claim recites a duplicate layer of nickel, zinc, and chromate on the same layers already formed in independent claim 1. However, no support is found in the specification for this limitation. Therefore, this limitation is deemed to be new matter.

Regarding claim 13, the instant claim recites the untreated copper foil does not have deposited modules. However, no support is found in the specification for this limitation. Therefore, this limitation is deemed to be new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "said smooth matte side" in line 6. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolski et al. '140 in view of Fatcheric et al.

Regarding claim 1, Wolski et al. '140 teach an electrodeposited copper foil wherein part of its surface comprises a rough surface having knob-like projections (or nodules, column 3 lines 18-22) and a surface roughness of 3.3 to 3.7 micrometer (on the matte side, see comparative example 1 in table 2 and table 3), which is within the range of the instant claim. In addition, the limitation "the copper foil is an untreated copper foil" is a process limitation, and thus is not given patentability weight, since the copper foil is distinguished by the surface roughness characteristic and not by whether it has been treated or untreated.

As described above, according to MPEP 2113, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

The difference between the reference to Wolski et al. '140 and the instant claims is that the reference does not explicitly teach whether the projections are intermittent, or

forming an additional nickel, zinc, cobalt layer or alloy thereof and a chromate layer.

Fatcheric et al. teach roughening treating the copper foil by depositing a fine nodular metal deposit, such as copper or copper alloy, in order to improve the adhesion to a substrate (Abstract). The nodules on the copper foil as seen in Fig. 2 are broadly interpreted to be intermittent. Furthermore, Fatcheric et al. teach an electrodeposited copper foil, wherein said electroforming bath is an acidic electroforming bath containing nickel, cobalt, zinc or arsenic for depositing the respective metal or alloys thereof (column 5 lines 7-17). Additionally, Fatcheric et al. teach an electrodeposited copper foil wherein said rough surface is further formed with a copper plating layer and at least one layer of nickel plating, zinc plating, cobalt plating, plating of an alloy of the same (column 5 lines 13-20) and a chromate treatment layer (column 5 lines 21-23) on that, or further formed with a coupling agent treatment layer (column 5 lines 21-24).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the foil of Wolski et al. '140 by forming the intermittent projections of Fatcheric et al., because it would improve the adhesion of the copper foil to a substrate. Furthermore, it would have been obvious to one having ordinary skill in the art to have expected that the foil of Wolski et al. '140 would have the intermittent projections of Fatcheric et al., because Wolski et al. '140 use the same process, i.e. depositing copper nodules on the foil, to treat the copper foil as that of Fatcheric et al.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the foil of Wolski et al. '140 by depositing a zinc

layer of Fatcheric et al., because the zinc layer provides a barrier layer between the copper foil and the laminating resin substrate in order to prevent laminate staining which occurs when ingredients of the resin chemically react with copper (column 4 lines 50-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have further modified the foil of Wolski et al. '140 by depositing a chromate layer of Fatcheric et al., because it would provide a protective layer for the underlying barrier layers (column 5 lines 21-22).

Regarding claim 2, Wolski et al. '140 teach an electrodeposited copper foil wherein part of its surface comprises a rough surface having knob-like projections (or nodules, column 3 lines 18-22) and a surface roughness of 3.3 to 3.7 micrometer (on the matte side, see comparative example 1 in table 2 and table 3) is a surface of an untreated copper foil for bonding with a resin substrate and is further roughening treated by running a predetermined current (table 1) through the foil for a predetermined time in an electroforming bath. The electrolysis is inherently performed for a predetermined time.

Regarding claim 3, Fatcheric et al. teach that an acidic copper plating bath but suggest that other alloys as well as metals such as nickel and cobalt can be used (column 5 lines 10-17). Furthermore, since the instant claim is directed to product, the electroforming bath used to make the product is not given patentability weight because it does not further structurally limit the product.

Regarding claim 4, Wolski et al. '140 teach an electrodeposited copper foil wherein said rough surface is further formed with a copper plating layer (column 5 lines

30-35).

Regarding claim 10, Fatcheric et al. teach a coupling agent treatment layer (column 5 lines 21-24).

Regarding claim 12, Wolski et al. '140 teach 3-mercapto propane sulfonate (column 4 line 67) and hydroxylethyl cellulose (Table 1). Furthermore, since the instant claim is directed to a product, the plating composition used to make the product is not given patentability weight because it does not further structurally limit the product.

Regarding claim 13, the instant claim is directed to an untreated copper foil that does not have deposited nodules. However, since the claim does not further structurally limit the product, Wolski et al. '140 read on the instant claim. Alternatively, since Wolski et al. '140 teach that the copper nodules are deposited to enhance the bonding strength of the foil with an insulating substrate (column 3 lines 18-22), it would have been obvious to one having ordinary skill in the art to have omitted the copper nodules if enhanced bonding strength of the copper foil is not desired.

### ***Response to Arguments***

Applicant's arguments filed on September 11, 2008 have been fully considered but they are not persuasive. In the arguments presented on page 5 of the amendment, the applicant argues that simply because a copper foil is untreated it does not have deposited copper nodules. While this may be true in some instances, the applicant's specification does not support this limitation, because the specification does not limit whether copper nodules can be deposited on the copper foil nor equate a treatment step with depositing copper nodules. Furthermore, it appears that this limitation is a



process limitation since it forbids the additional deposition of copper nodules on the surface of the copper foil. As noted above, since the instant claims are directed to a product, the method of making the product is not given patentability weight. Even if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product is made by a different process.

With respect to the argument that the copper foil of Wolski et al. '140 is structurally distinguishable from an untreated copper foil, it is noted that independent claim 1 does not limit the claim to any particular treatment. The copper foil can be regarded as an untreated copper foil if, for example, it was not formed with a particular additive or washed in a particular manner. Therefore, a copper foil even though it has deposited copper nodules can be deemed as an untreated copper foil. Furthermore, the examiner maintains the position that the limitation "the copper foil is an untreated copper foil" is a process limitation, and thus is not given patentability weight, since the copper foil is distinguished by its structure and not by whether it has been treated or untreated.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan V. Van whose telephone number is 571-272-8521. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on 571-272-1342. The fax phone number for

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the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Nam X Nguyen/  
Supervisory Patent Examiner, Art Unit 1753

LVV  
February 26, 2008